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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,052	02/02/2005	Yuichi Awakura	035-05	7572

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PAUL AND PAUL
2000 MARKET STREET
SUITE 2900
PHILADELPHIA, PA 19103

EXAMINER

EVANS, GEOFFREY S

ART UNIT	PAPER NUMBER
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1725

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/27/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/27/2007.

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Office Action Summary	Application No. 10/523,052	Applicant(s) AWAKURA, YUICHI	
	Examiner Geoffrey S. Evans	Art Unit 1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20061221</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The previously indicated allowability of claims 1-8 in the previous office action is withdrawn in view of the newly discovered prior art reference (Kataoka in Japan Patent No. 5-329,714). The delay in citing this reference is regretted.

2. Claim 2 is objected to because of the following informalities: In claim 2 on line 3 the word "electrode" is misspelled as "1.ectrode". Appropriate correction is required.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3,5,6,9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshiyuki in Japan Patent No. 8-229,747 in view of Lin in U.S. Patent Application Publication No. 2003/0192861 and Katoaka in Japan Patent No. 5-329,714. Yoshiyuki discloses mounting an electrode guide holder (element 19) on an electrode holder (element 34, which is an electrode magazine) having an electrode(element 17) held therein in advance, mounting the electrode holder on a member (element 13), moving the electrode guide to a distal end of the electrode 10 to support the electrode(see step (3) in paragraph 6) and moving said electrode and said workpiece relative to each other to position said electrode at a position on the workpiece and starting electric discharge machining(see claim 1 of Yoshiyuki. Yoshiyuki does not disclose that the rotatable member (element 13) is a spindle. Lin (861) teaches using a spindle (element 6, see

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paragraph 19) in an electric discharge machine apparatus to rotate the electrode and teaches moving the electrode in position with respect to the workpiece and starting the electric discharge machining. Katoaka teaches a gripping means (element 10) for more accurately moving a tool into position. It would have been obvious to adapt Yoshiyuki in view of Lin and Katoaka to provide this to provide a spindle to rotate the electrode and to use gripping means to more accurately place the electrode in position for starting electric discharge machining to drill a hole in the workpiece.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshiyuki in Japan Patent No. 8-229,747 in view of Lin in U.S. Patent Application Publication No. 2003/0192861 and Katoaka in Japan Patent No. 5-329,714 as applied to claims 1 and 2 above, and further in view of Nagata in U.S. Patent No. 6,211,480. Nagata teaches an electrode holder with a flow path for supplying dielectric fluid into a pipe electrode. It would have been obvious to adapt Yoshiyuki in view of Lin, Katoaka and Nagata to provide this to ensure that the pipe electrode receives working fluid.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshiyuki in Japan Patent No. 8-229,747 in view of Lin in U.S. Patent Application Publication No. 2003/0192861 and Katoaka in Japan Patent No. 5-329,714 as applied to claims 1 and 2 above, and further in view of Yokomichi in U.S. Patent Application Publication No. 2005/0077269 A1. Yokomichi teaches an electrode guide holder with a taper end (see element 77a in figure 6). It would have been obvious to adapt Yoshiyuki in view of Lin, Katoaka and Yokomichi to provide this to reduce the chance of collision of the electrode guide holder with the workpiece.

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7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshiyuki in Japan Patent No. 8-229,747 in view of Lin in U.S. Patent Application Publication No. 2003/0192861 and Katoaka in Japan Patent No. 5-329,714 as applied to claims 1 and 2 above, and further in view of Gleason et al. in U.S. Patent No. 6,127,642. Gleason teaches an anti-vibration guide (element 36). It would have been obvious to adapt Yoshiyuki in view of Lin, Katoaka and Gleason et al. to provide this to reduce vibrations.

8. Applicant's arguments with respect to claims of record have been considered but are moot in view of the new ground(s) of rejection.

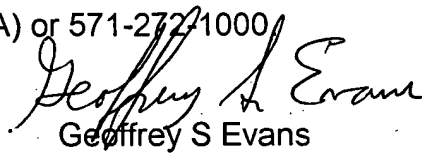
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Beck in U.S. Patent No. 5,945,009 has gripping means used to replace workpieces. Mizoguchi in Japan Patent No. 61-109,640 uses a gripping means (element 24) for replacing an electrode holder.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S. Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 6:30AM to 4:00 PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on (571)-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Geoffrey S Evans
Primary Examiner
Art Unit 1725

GSE